



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/090,067	06/03/98	REDMOND J	NIS0007

POLAROID CORPORATION
PATENT DEPARTMENT
748 MEMORIAL DRIVE
CAMBRIDGE MA 02139

QM32/0327

EXAMINER

HENDERSON, M

ART UNIT

PAPER NUMBER

3722

18

DATE MAILED: 03/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/090,067

Applicant(s)
Redmond et al

Examiner
Mark T. Henderson

Group Art Unit
3722



☒ Responsive to communication(s) filed on Dec 27, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1, 3-6, 8-11, 13-16, 18-21, and 23-26 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 3-6, 8-11, 13-16, 18-21, and 23-26 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3722

DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1, 11 and 21 have been amended for further examination. Claim 1 has been amended to overcome the previous 112 rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3722

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-6, 8-11, 13-16, 18-21 and 23-26 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Craven et al in view of Merry et al.

Craven et al discloses a method and apparatus for manufacturing tamper-resistant identification cards comprising first printed matter (16) at a first location and a first scale, wherein the first printed matter (16) is viewable by a person without magnification; a second printed matter (20) representing the first printed matter (16) rendered at a second scale and location and in a second color, wherein the second scale being significantly smaller than the first scale and wherein the second location being spaced from the first location, and the second color being of any desirable color selected to effect contrast at any degree (Col. 3, lines 1-5) between the second printed matter and its immediate background; and wherein the first and second printed matter conveys identifying information and is specific to the identified person.

However, Craven et al does not disclose a second color to minimize contrast between the second color and the second location; the first and second printed matter comprising at least two digits of the year of a birth of a person, the second printed matter being a graphical reproduction of the first printed matter; and a plurality of identification documents.

In regards to **Claims 1, 11 and 21**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select a color to contrast at any degree whether it at a maximum or minimum, since it has been held that where the general conditions of a

Art Unit: 3722

claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

3. In regards to **Claims 6, 9, 13, 16, 18-20, and 26**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desirable indicia, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate.

In regards to **Claim 11**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct any desirable amount of identification documents, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Response to Arguments

4. Applicant's arguments filed on December 27, 2000 have been fully considered but they are not persuasive.

Art Unit: 3722

In response to applicant's argument that the Craven reference does not teach "to minimize the contrast to render the second printed matter much less perceptible to an unassisted eye", the examiner submits Craven does teach that the second printed matter is contrasted (Col. 3, lines 1-5). The examiner also submits that although there is a **minimization of the contrast**, there is still a contrast in color. As a result, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the second printed matter to contrast at any degree (whether at a maximum or a minimum), since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Furthermore, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In response to applicant's argument that the Merry et al reference does not teach "to provide duplicate information which is only revealed with magnification, the examiner submits that Merry et al does reveal indicia which is revealed through magnification. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desirable indicia, since it would only depend on the intended use of the assembly and the desired

Art Unit: 3722

information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3722


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

March 20, 2001



A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700